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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/997,142 12/23/97 ISMAN M 07470020001

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EXAMINER

ZHEN, W

ART UNIT

PAPER NUMBER

2762

DATE MAILED:

07/13/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/997,142

Applicant(s)
Marshall A. Isman

Examiner
Wei Zhen

Group Art Unit
2762



☒ Responsive to communication(s) filed on May 11, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 5, 7, and 9 is/are rejected.

☒ Claim(s) 4, 6, 8, and 10 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 5/11/99 have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that the claims 1-3, 5, 7 and 9 specify generating performance characteristics of an application and therefore, they specify useful, concrete and tangible results and are directed to statutory subject matter (see 35 U.S.C. 101 and State Street Bank & Trust Co. V. Signature Financial Group, Inc., 149 F.3d 1368 (Fed. Cir. 1998)). The examiner disagrees.

The claims 1-3, 5, 7 and 9 in the present applications are directed to non-statutory subject matter such as mathematical algorithm or an abstract idea without a practical application. The practical application in State Street Bank & Trust Co. V. Signature Financial Group, Inc does not correlate to applicant's claims and it does not apply.

As stated in the previous office action, the present claims 1-3, 5, 7 and 9 are directed to non-statutory subject matter because they are mathematical algorithm or abstract idea without limitation to practical applications and they are non-statutory. The present claims 1-3, 5, 7 and 9 are method claims and are a series of steps. The results of these steps are merely measurements of data and data gathering. The results are not utilized after they are generated to make the machine function differently, therefore, they don't have any practical application. However, claims 4, 6, 8 and 10 are statutory because the results are utilized after they are generated in these

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claims indicating a practical application. In summary, treating the process that performs the recited steps indicates that it does manipulate an abstract idea without a practical application. Therefore, they are not statutory.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wei Zhen whose telephone number is (703)305-0437.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached at (703) 305-9643. The fax number for this group is (703)308-1396.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)305-9600.

Wei Zhen

7/8/99


Tariq R. Hafiz
Supervisory Patent Examiner
Technology Center 2700